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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,886	06/07/2001	Toru Kuwahara	100809-16266 (SCET 18.734	7805
26304	7590	03/25/2005	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,886

Applicant(s)

KUWAHARA, TORU

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant amended Claims 8-10, and extensively amended Claim 9 due to missing claims elements as originally filed. All pending claims (1-10) were examined in this non-final Office Action.

Response to Arguments

Rejection under 35 USC 102

Applicant's arguments filed 23 December 2004 have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with the Applicant regarding displaying. Fredregill teaches products that are about to be purchased prior to making payment and depicts a remotely connected electronic point-of-sale terminal with a display that provides information (see at least Fig. 1 (12)). Fredregill teaches prior art systems that display incentives to potential customers via advertising or printed coupons to encourage product purchases (see at least col. 1, lines 18-44). Though not relied upon,

- the Examiner firmly believes that Fredregill's attempts to overcome limitations of advertisements and coupons via a points-reward system is not at the expense of losing the old and well known visual impact of advertisements and coupons.

- Fredregill inherently discloses displaying product information- the shopper has physical possession of one or more products to be purchased, each product by its physical nature or packaging is self-displaying information about the product, and any computer-based means of displaying product information is an obvious substitute for the real thing.
- furthermore, since Fredregill is focused on creating sales through rewards prior to purchase, Fredregill's point-of-sale display is extremely useful in at least maintaining prior art incentives by at least displaying to the customer the difference between spending \$10.00 vs. \$9.99 (Table 1: \$9.99 or less earns zero points but \$10.00 earns 5 points), or displaying prior to purchase that tobacco or alcohol products do not earn rewards (please see at least col. 4, lines 44-46; TABLE 1, col. 5, lines 1-17 as cited in the previous office action).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-10 and 12 are rejected under 35 USC 102(e) as being anticipated by Fredregill et al. (Paper #2, US 5,923,016, hereinafter referred to as "Fredregill").**

Fredregill teaches all the limitations of Claims 1-12. For example, Fredregill discloses a computer implemented consumer transaction point accumulation system means and method (see at least abstract; Fig. 1 (10, 12, 30, 40); col. 2, lines 18-57). Fredregill further discloses:

- Storing commodity information: stores name and price in master index using database storage means (see at least Fig. 1 (10); col. 11, lines 1-10). Please note examiner's interpretation: first storage means.
- Storing periods applied to specific commodities; parameters and relating periods: bonus points earned on specially promoted items (see at least col. 4, lines 23-25); defining start/stop date for specific item that maintains bonus point status (see at least col. 10, lines 3-5); storage means specific to commodity parameters (see at least Fig. 1 (30); col. 9, lines 56-62). Please note examiner's interpretation: second storage means for start/stop date and third storage means for storing economic value.
- Storing a general-purpose parameter concerning economic return which is applied to commodities other than said specific commodities and to specific commodities for which periods to not include dates related to orders of the specific commodities: breakpoint parameter for sales transactions that generates regular points for commodities not exempt

from regular or bonus points- not related to specific period; applying bonus points in lieu of applying a general parameter (see at least col. 4, lines 21-23, 56-59; col. 5 (Table 1)).

- Receiving a request for displaying information on commodities: POS display means for displaying requested commodity information (see at least Fig. 1 (12); col. 4, lines 25-27).
- Point generating means: (see at least col. 4, lines 15-20).
- Calculation means for first points: computer calculates regular points (see at least col. 4, lines 15-20).
- Calculation means for second points: computer calculates bonus points (see at least col. 4, lines 15-20).
- Calculation means base on eligible items: computer calculates exempt items (e.g. tobacco, alcohol) (see at least col. 4, lines 45-46).
- Software: software used to access host application; accessing the application controlling the system (see at least Fig. 1 (10; 30, 40); col. 7, lines 13-65). Inherent in the system and method of Fredregill is computer readable memory that stores program executed by a computer.
- Start/stop periods for rewards: (see at least Fig. 1 (12); col. 10, lines 1-25).
- Consumer identification and total points: stores customer account records and point balance (see at least col. 3, line 49 through col. 4, line 12).

Please note examiner's interpretation: fourth storage means.

Pertaining to system Claims 1-6

Rejection of Claims 1-6 is based on the same rationale as noted above.

Pertaining to computer and program code Claims 8 and 9

Rejection of Claims 8 and 9 is based on the same rationale as noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claim 11 is rejected under 35 USC 103(a) as being unpatentable over Fredregill (Paper #2, US 5,923,016) in view of Official Notice (old and well known).**

Fredregill teaches all the above as noted under the 102(e) rejection and teaches a) storing consumer points and account records in a fourth storage means, b) providing a means for making corrections to the customer point balance in the customer account, and c) recovering points when merchandise is returned (please note examiner's interpretation: i) same as canceling an order, and ii) retailer awards points based on making a sale as defined by the shopper purchasing, taking possession, and keeping the purchased product(s)) (see at least col. 8, lines 2-7). Fredregill, however, does not disclose crediting points as

of a delivery date when the order request and delivery are non-coincident. The Examiner takes the position that is old and well known for purchased product to be canceled prior to taking delivery (e.g. back-ordered product). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Fredregill to disclose crediting points as of a delivery date when the order request and delivery are non-coincident, in order to eliminate an unnecessary process, since it is old and well known for shoppers to cancel a purchase prior to taking delivery as taught by Official Notice, thereby eliminating situations wherein a retailer is awarding points for product canceled prior to delivery.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

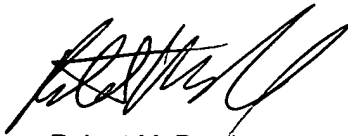
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
March 19, 2005